

Remarks

Applicants wish to thank the Examiner for the courtesies extended to the undersigned during the telephone interview. An interview summary accompanies this response. Applicants also thank the Examiner for the recognition of allowable subject matter in the present application.

Applicants hereby add new claim 28. Accordingly, claims 1-21, 25, and 27-28 are pending in the present application.

Claims 16-18 and 21 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No 4,167,322 to Yano et al. in view of U.S. Patent No 6,023,593 to Tomidokoro. Claims 19-20 stand rejected under 35 USC 103(a) for obviousness over Yano et al. in view of Tomidokoro and further in view of U.S. Patent No. 6,108,099 to Ohtani.

Applicants respectfully traverse the rejections and urge allowance of the present application.

With respect to the rejection of claim 1, Applicants have amended the claim to return it to its original form in view of the rejection of other claims previously indicated to be allowable and the fact that Applicants only amended claim 1 to facilitate allowance of the present application. Applicants respectfully submit claim 1 is allowable for at least the following compelling reasons as discussed during the interview.

More specifically, Applicants respectfully submit to properly establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed.).

Yano discloses at col. 2, lines 39+ that display units 17 are capable of displaying copying machine status parameters such as toner amount remaining at others of the copying machines. Col. 4, lines 5 + of Yano state that a user may use a keyboard to select the parameters to be displayed. Accordingly, Yano is concerned with displaying parameters of consumables. As set forth in the Office

Serial No. 09/710,404  
PDNO. 10003221-1  
Amendment C

Action of the present application, Yano is not concerned with communicating orders for replenishing copy sheets or toner (see page 3 of the Action). The Office relies upon the teachings of Tomidokoro to allegedly cure the deficiencies of Yano and on page 3 of the Action states that the combination of the references is appropriate to modify the teachings of Yano by providing a means for enabling a copying machine to create and transmit a consumable order request in the manner disclosed by Tomidokoro. Applicants respectfully submit that the Office has failed to set forth sufficient motivational rationale for a proper prima facie rejection.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

Applicants respectfully submit there is no objective evidence of record to support the combination of reference teachings and the motivation must accordingly only be based upon improper subjective opinions of the Examiner or unknown authority. In support of the position that motivation exists to combine the reference teachings, the Office on page 3 states that it is obvious to combine the references by providing a means for enabling a copying machine to create and transmit a consumable order request. Applicants respectfully submit that the alleged motivation relied upon by the Office is merely a result if the teachings are

Serial No. 09/710,404  
PDNO. 10003221-1  
Amendment C

*combined*. However, Applicants respectfully submit the mere result of the combination without more evidence has been held by the Federal Circuit to be insufficient to motivate one of skill in the art to make the proposed combination in the first instance. In particular, Applicants respectfully submit that preferably the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification. *Ex Parte Levensgood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted). The mere result of the combination fails to provide the necessary impetus to cause one to combine the references in the first instance. There is *no evidence of record* to support the combination and the motivational argument presented by the Office is deficient for at least this reason.

In addition, Applicants respectfully submit that even if motivation exists to extensively modify the copying machines of Yano to enable generic ordering thereof, there is no motivation to modify Yano to arrive at the invention of claim 1 specifically reciting the image forming device configured to implement plural consumable order assist functions including the initial and the another consumable order assist functions.

The Office has failed to recite any objective evidence of record to support the position of the Office with respect to motivation and accordingly the motivation is insufficient in view of the applicable authority. Even if motivation exists to provide consumable ordering in the copying machines of Yano there is no motivation to modify the copying machines of Yano to implement plural consumable order assist functions. Applicants respectfully submit the Office has failed to establish a proper 103 rejection for at least this reason and claim 1 is allowable.

Further, Applicants respectfully submit that even if the references are combined, positively recited limitations of claim 1 are not disclosed nor suggested by the prior art and the Office has failed to establish a proper prima facie 103 rejection for this additional reason. More specifically, the Office recites teachings of Tomidokoro of transmitting a consumable order request in response to a polling signal. Applicants respectfully submit that such teachings at most describe a single consumable order assist function and fail to disclose or suggest the claimed image forming device configured to implement plural consumable order assist functions

Serial No. 09/710,404  
PDNO. 10003221-1  
Amendment C

*including the initial and the another consumable order assist functions.* Also, even if combined, the combined teachings of the prior art are void of teaching or suggesting *replacing the variable* to control formulation of another consumable order assist function instead of an initial consumable order assist function as recited in claim 1.

Claim 1 also recites *formulation of the another consumable order assist function by the processing circuitry responsive to the reception of the signal from the sensor configured to monitor a status of the consumable.* The combined teachings of the prior art merely state that the order of Tomidokoro is sent after a polling signal is received from externally of the copier machine which fails to teach the claimed limitations of claim 1 including the formulating the another consumable order assist function responsive to the signal from the consumable sensor.

Applicants respectfully submit at least these limitations are not disclosed nor suggested by the prior art and claim 1 is allowable for these compelling reasons.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.* Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 1 is not found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 5, and prior to the amendment to claim 1, the

Serial No. 09/710,404

PDNO. 10003221-1

Amendment C

Examiner relies upon the teachings of Ohtani as allegedly disclosing limitations of claim 5. However, the teachings of Ohtani are inapplicable to the teachings of Tomidokoro and the 103 rejection is improper for at least this reason. More specifically, as set forth in cols. 6-7 of Tomidokoro, data communication apparatus 200 polls individual copiers 100, compiles a list of the consumables needed, and thereafter sends the data to central controlling device 400 as set forth in col. 7, lines 45-60. At col. 13, central controlling device 400 orders the consumable from consumable item supplier 500. Accordingly, Tomidokoro already provides a system for ordering a consumable from a supplier 500 associated with device 400. It follows that Tomidokoro does not disclose and has no need for processing circuitry of the image forming device to formulate the consumable order assist function to include an identifier of a supplier of the consumable in view of the arrangement of device 400 ordering from existing supplier 500. There is no motivation or need to look to Ohtani to modify the already explicit teachings of Tomidokoro and the 103 rejection is improper for at least this reason. In view of the disparate reference teachings, the motivation for forming a combination of references or modification thereof only improperly results from hindsight reconstruction based on using the Applicant's invention as a road map for such a combination or modification. See, for example, *Interconnect Planning Corp. vs. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Claim 5 is allowable for this additional reason.

In sum, Tomidokoro already provides a system and method for ordering a consumable from supplier 500. Accordingly, there is no need for a copier to store an identifier of a supplier as alleged in the Action. Further, the combination would change the basic principle under which the construction of Yano was designed to operate. There is no motivation to combine the reference teachings and the rejection of claim 5 is improper.

Referring to claim 6, the combination is inappropriate in view of the Tomidokoro teachings providing central controlling device 400 ordering from existing consumable item supplier 500. Apart from Applicants' disclosure, there is no need or motivation to modify Tomidokoro to provide processing circuitry of an image forming device configured to formulate the another consumable order assist function comprising an identifier of the purchaser of the imaging consumable as

Serial No. 09/710,404  
PDNO. 10003221-1  
Amendment C

claimed. Claim 6 is allowable for at least this reason.

Further, the alleged motivation recited on page 12 of the Action is contrary to the explicit reference teachings. Tomidokoro already provides device 400 configured to place orders from supplier 500. In view of the system management teachings of device 400 of Tomidokoro, there is no need or motivation for processing circuitry of a copier to include an identifier of a purchaser of a consumable in the consumable order assist function as claimed. Claim 6 is allowable for this additional reason.

Applicants appreciate the indication that claims 8-15 recite allowable subject matter.

Referring to independent claim 16, there is no proper motivation recited to support a proper prima facie rejection of claim 16 and claim 16 is allowable for at least this reason. In addition, even if the Yano and Tomidokoro references are combined, the combination of reference teachings fails to disclose or suggest the *initial and the another consumable order assist functions* as positively claimed. Further, the art is void of teaching detecting an amount of consumable being at a predetermined status and *generating the another one of the consumable order assist functions responsive to the detecting* and the replacing of the initial variable with the another variable. Tomidokoro teaches *outputting the order responsive to the polling signal not a predetermined status*. Positively recited limitations of claim 8 are not disclosed nor suggested by the prior art and claim 8 is allowable for this additional reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 17, it is stated on page 9 of the Action that in order to receive information regarding a parameter a remote query language must inherently be used. Applicants respectfully disagree. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Numerous alternative

Serial No. 09/710,404  
PDNO. 10003221-1  
Amendment C

remote communications protocols besides remote query language exist. Accordingly, in no fair interpretation may the remote query language be considered inherent when numerous suitable alternative communications protocols may be used. The allegedly inherent limitations do not necessarily flow from the teachings of the prior art and claim 17 is allowable for this additional compelling reason.

Referring to claim 19, the combination of reference teachings of Yano and Tomidokoro utilizes a polling signal from the remote device and which would identify the remote device and accordingly there is no teaching or suggestion in the prior art to formulate an initial consumable order assist function to comprise an identifier of a supplier of the consumable in view of the identity of the remote device of Tomidokoro already being known and device 400 of Tomidokoro knowing where to place an order for the consumable. There is no need to modify Tomidokoro and there is no motivation to combine the teachings of Ohtani and claim 19 is allowable for this additional reason.

Referring to claim 20, the combination of reference teachings utilizes a polling signal from the remote device and which identifies the remote device and the copying machine and accordingly there is no teaching or suggestion in the prior art to formulate an another consumable order assist function to comprise an identifier of a purchaser of the consumable in view of the identity of the remote device of Tomidokoro already being known. There is no need to modify Tomidokoro and there is no motivation to combine the teachings of Ohtani. Further, there is no teaching of the another consumable order assist function comprising an identifier of the image forming device inasmuch as the remote device of Tomidokoro communicates the polling signals to the copying machines and already knows the identities of the machines. Claim 20 is allowable for this additional reason.

Referring to claims 20-21, it is alleged on pages 10, 11 of the Action that limitations of claims 20-21 are well known. Applicants traverse the assertion that the limitations are well known and request the submission of prior art or affidavit in support of a rejection of the claims if the claims are not allowed in the next Action. In particular, the undersigned hereby traverses and seasonably challenges such assertion pursuant to MPEP §2144.03 (8<sup>th</sup> ed.), and requests the Examiner cite a reference in support of his or her position. Applicant believes reasonable doubt

*Serial No. 09/710,404  
PDNO. 10003221-1  
Amendment C*

15

exists regarding the Examiner's assertion of judicial notice. The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually.

In particular, Applicants respectfully submit it is not well known for the another consumable order assist function to comprise an identifier of the image forming device inasmuch as Tomidokoro utilizes a polling arrangement wherein the remote device knows the identity of the copying machines and accordingly there is no need for identifiers of the copying machines in the ordering functions from the copying machines of Tomidokoro. Applicants respectfully assert claims 20-21 are allowable for at least these reasons.

Applicants hereby add new dependent claim 28 which includes the limitations of the previously allowed claim 1.

Applicants respectfully request allowance of the application for at least the above-mentioned compelling reasons.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Robert E. Haines  
Mark A. Harper

By:

  
James D. Shaurette

Reg. No. 39,833

Date: 7/7/05

Serial No. 09/710,404  
PDNO. 10003221-1  
Amendment C